

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

DUFT et al

Appl. No.: **08/870762**

Filed: June 6, 1997

For: **Methods For Treating Obesity**

Confirmation No.: **7328**

Art Unit: **1645**

Examiner: **Sarvamangala J.N. DEVI**

Atty. Docket: **226/104US**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition Under 37 CFR §1.181(a)

For the above-identified application, Appellant respectfully requests that in view of newly cited art first provided in the Examiner's Communication dated February 12, 2009, that at least one of the grounds of rejection that rely on this reference as set forth in the Examiner's Answer be designated as a new ground of rejection under 37 CFR §41.39(b). Specifically, Appellant requests that at least one of the grounds of rejection designated as sections "C", "E", "F", "G" and "H" in the Examiner's Answer be designated as a new ground of rejection.

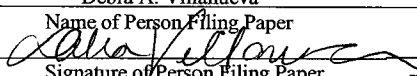
Statement of Facts

In the Final Office Action and the Advisory Action of the present application, the Examiner rejected the appealed claims directed to treating obesity by citing and relying on an English abstract of a foreign reference. The abstract was cited as "Tsanev (Vutr. Boles 23:12-17, 1994, abstract)" and hereafter is referred to as the "Abstract" (attached as Exhibit 1). Neither the full underlying foreign language scientific paper nor a full certified English translation of the full foreign language scientific paper was made of record at that time. Appellant filed an Appeal Brief on August 7, 2008, in which the several grounds of rejection relying upon the Abstract were addressed. The Examiner's Answer was filed which relied on the Abstract specifically at the grounds of rejection designated as sections "C", "E", "F", "G" and "H" in the Examiner's Answer. Appellant filed a Reply Brief on December 11, 2008, addressing this ground for each of these rejections. Subsequently, on February 12, 2009, the Examiner provided and first made of record in this case the full underlying foreign language scientific paper by

CERTIFICATE OF TRANSMITTAL UNDER 37 C.F.R. 1.8

I hereby certify that this paper (along with anything referred to as being attached or enclosed) is being electronically filed via EFS-Web at the United States Patent and Trademark Office, on the date shown below.

April 13, 2009
Date of Deposit

Debra A. Villanueva
Name of Person Filing Paper

Signature of Person Filing Paper

Tsanev and an English translation, cited as “Tsanev A. Vutr. Boles. 23: 12-17, 1994”, hereafter referred to as the “Scientific Paper” (attached as Exhibit 2).

The Examiner’s Answer relies heavily on a specific quotation from the Abstract; however, the corresponding quotation in the newly submitted Scientific Paper is dissimilar to that in the abstract and does not support the Abstract. The corresponding but different quotation in the Scientific Paper, as well as the new and more detailed disclosures in the Scientific Paper, provide new matter which provides a new basis for each of these rejections.

For example, the Abstract’s recitation of “Age type diabetes” as found in lines 1-2, and its discussion of obesity were relied upon in the Examiner’s Answer. However, the newly provided Scientific Paper makes absolutely no mention of this term. This term is ambiguous and is undefined in the Abstract and is not an accepted medical name for any diabetes state. In contrast, the Scientific Paper refers to conventional albeit outmoded names for diabetes states, and inter alia, refers to groups of diabetes patients that are not obese.

Another example of language in the Abstract heavily relied upon the Examiner’s Answer but not found in and different from the Scientific Paper, is the Abstract’s recitation that “80-90 percent of them being with overweight” as stated in lines 2-3. However, the Scientific Paper recites that “80-90% of them have above-normal weight” at page 12 (“/12*”) of the English translation. The terms “overweight” and “above-normal weight” are not medically equivalent. Accordingly, the newly provided Scientific Paper made of record after the Appellant’s Reply Brief was filed provides new facts, matters and issues not found in the Abstract and thus provides a different basis and grounds for the present rejections. Even though the statutory basis for the rejections remain the same, the evidence provided by the Scientific Paper that will now be relied upon in support of the previous rejections based on the Abstract is different, and thus each rejection now based on the Scientific Paper constitute a new ground of rejection.

Because the Scientific Paper was entered after Appellant’s Reply Brief, Appellant has not been provided a fair opportunity for consideration and/or response to the teachings of this reference.

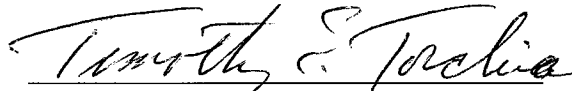
Appellant further objects that the translation provided by the Examiner does not on its face appear to be a "certified translation" as required by the Board of Patent Appeals and Interferences pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy.

Conclusion

In view of the foregoing, Appellant respectfully request that this petition for declaring new grounds of rejection be approved. Appellant submits that it has not been provided a fair opportunity for consideration of and/or response to the teachings of this newly cited reference.

This petition is believed to be timely filed pursuant to 37 CFR §1.181(a). The fee for this petition as set forth in 37 CFR §1.17(f) in the amount of \$400 will be paid herewith; however, if any fees are still believed due the Commissioner is authorized to charge Appellant's Deposit Account No. 010535.

Respectfully submitted,
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Date: April 10, 2009
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Attachments:

- Exhibit 1 (uploaded herewith via EFS as "Exhibit 1 – Abstract")
- Exhibit 2 (uploaded herewith via EFS as "Exhibit 2 – Scientific Paper" + Translation)